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21171	7590	12/10/2003	EXAMINER	
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STAAS & HALSEY LLP		ART UNIT		PAPER NUMBER
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DATE MAILED: 12/10/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/520,810	FUKUYAMA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Anh-Vu H Ly	2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 September 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 11,18-24,26,27 and 35 is/are allowed.
- 6) Claim(s) 1-10,12-17,25,28-34,36 and 37 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____                                     |

**DETAILED ACTION**

***Response to Amendment***

1. This communication is in response to applicant's amendment filed September 10, 2003.

The proposed amendment to the claims has been entered. Claims 1-37 are pending.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 28, 30, 32, 34, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima (US Pub No. 2002/0004802).

With respect to claim 1, Shima discloses in Fig. 1, a functional configuration for implementing requested instructions from the information terminal 11 (information terminal) by the image information input-output unit 1 (a terminal) through a data network (communication on a packet switched network). Such data network can be further illustrated in Figs. 3, 9, and 20, network 100 for connecting the information terminal and the image information input-output unit such as a scanner, a printer or a web server. Shima discloses (page 2, 11<sup>th</sup> and 12<sup>th</sup> paragraph and Fig. 1) when retrieval information is entered from the outside of the image information input-output unit 1 (sending from the information terminal to the terminal an instruction related to control of the terminal on the packet switched network), the conversion means 5 look up in the management table 5 and converts the retrieval information into predetermined control information. For example, when a URL of http://xxx/action/300 dpi is entered, if "action/300

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dpi/” is previously related to the control information meaning “read image at read resolution 300 dpi” in the management table 4, the URL is converted into control information by the conversion means 5, whereby the image read operation at 300 dpi is executed (controlling from the terminal at least one of a communication function and a function of the terminal on the packet switched network in accordance with the instruction from the information terminal).

Shima does not disclose that the terminal is a phone terminal. However, voice communications over the packet switched network has been long known in the art. Therefore, it would have been obvious to one having ordinary skilled in the art at the time the invention was made to replace a scanner or a printer with a phone device in Shima’s system, and carry out the same method as taught by Shima, for controlling devices located separated over a packet switched network.

With respect to claims 2-4, 34, 36, and 37, Shima discloses in Fig. 1, a functional configuration for implementing requested instructions from the information terminal 11 (information terminal) by the image information input-output unit 1 (a terminal). Shima discloses (col. 1, 6<sup>th</sup> paragraph) image information input-output units have been often shared through various networks such as a LAN and an intranet (communication on a packet switched network).

Shima discloses in Fig. 1, the information terminal 11 (information terminal) comprising a read retrieval means 12 (a terminal controller) for generating retrieval information. Further Shima discloses (page 2, 12<sup>th</sup> paragraph) wherein retrieval information is used to indirectly specify control information, whereby predetermined image information input-output processing

is performed. Thus if the user uses an information terminal that can issue retrieval information for using the hypertext information retrieval environment 2 resided within the image information input-output unit 1 (information terminal includes a terminal controller that generates a control command based on an instruction from a user, the control command including an instruction related to control of the terminal, and information terminal being configured to send the instruction to the terminal).

Shima discloses in Fig. 1, the image information input-output unit 1 (terminal) comprising an information retrieval environment 2 for implementing the retrieval information sent by the information terminal 11 (a phone controller that controls at least one of a media communication function and a terminal function on the packet switched network, according to the control command from information terminal).

With respect to claim 5, Shima discloses in Fig. 20, image information processing system comprising the information terminal 61 (information terminal), a management server 121, a plurality of scanners and printers (a plurality of terminals). Shima discloses (page 13, 219<sup>th</sup> – 224<sup>th</sup> paragraphs) an operation executed among the information terminal 61 (information terminal), the management server 121 (one of the terminals), and the scanner 121 (another terminal). When the information terminal 61 requests the web server section 123 of the management server 121 to transfer a general page WP21 (sending from information terminal to a one of terminals an instruction related to multimedia communication on the packet switched network). If the user chooses a desired parameter out of a read resolution choice page, a URL indicating the parameter is sent to the management server 121. The URL interpretation section

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126 of the management server 121 converts the received URL into a predetermined control command. The control command is transmitted to a predetermined scanner 131, which then interprets the control command, executes scan processing, and transfers an image file provided by scanning to the management server 121, which then transfers the image file received from the scanner 131 to the information terminal 61 (performing in one of communication terminals the multimedia communication with another terminal on the packet switched network according to the instruction from the information terminal).

With respect to claims 28, 30, and 32, Shima discloses (page 13, 219<sup>th</sup> – 224<sup>th</sup> paragraphs) when the information terminal 61 requests the web server section 123 of the management server 121 to transfer a general page WP21, the management server 121 returns the general page WP21 to the information terminal 61. The general page WP21 is a page indicating the business machines connected to the network 100 for each type, such as scanners and printers, as shown in Fig. 22 (a control target list storing information relating to a predetermined terminal also connected to the packet switched network). If the user chooses a desired parameter out of a read resolution choice page, a URL indicating the parameter is sent to the management server 121 (a controller transmitting, based on an instruction from the user selecting the predetermined terminal, a multimedia communication control command to the user selected predetermined terminal).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 5, 29, 31, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Szlam (US Patent No. 6,359,892).

With respect to claim 5, Szlam discloses in Fig. 1, the portable communication device 10 (information terminal) connects to the outside party 12, main office 13, branch office 14, and other office 15 via a the communication links 11. Further, as illustrated in Fig. 2B, a plurality of office equipments, resided within the main office 13, are, but not limited to, telephone sets 217A-C, computers 221A-C, corporate devices, equipment, resources and services 220, etc... (a plurality of communication terminals). Szlam discloses (col. 8, lines 32-40) the communication links may be the cellular telephone service, satellite link services, private carriers, the Internet via an ISP (packet switched network), two-way cable service, ATM lines, etc....

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Szlam discloses (col. 9, lines 47-51) that the controller 225, as illustrated in Fig. 2B, can receive commands from the remote communication device 10 (sending from the information terminal to a first of communication terminals an instruction related to media communication on the packet switched network), converts these commands to CTI commands, and send the CTI commands to the appropriate device, such as the PBX 216 (performing in first of communication terminal media a communication with a second of communication terminals on the packet switched network in accordance with the instruction from the information terminal).

With respect to claims 29, 31, and 33, Szlam discloses (col. 20, lines 9-11) the user of the remote communication device 10 (information terminal) can store a user profile in the controller 225 (a communication terminal) which the controller 225 inspects whenever an incoming call for the user is received (a terminal list wherein is stored information relating to a predetermined information terminal also connected to the packet switched network). Szlam discloses (col. 9, lines 47-51) that the controller 225, as illustrated in Fig. 2B, can receive commands from the remote communication device 10, converts these commands to CTI commands, and send the CTI commands to the appropriate device, such as the PBX 216 (a second control means that receives from predetermined information terminal a control command wherein is recorded an instruction related to media communication, and performs, based on the control command, media communication with another communication on the packet switched network).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-10, 12-17, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima (US Pub No. 2002/0004802) in view of Szlam (US Patent No. 6,359,892).

With respect to claims 6, 8, 12-17, 25, Shima discloses in Fig. 20, image information processing system comprising the information terminal 61 (information terminal), a management server 121, a plurality of scanners and printers (a plurality of terminals) on network 100 (communication on a packet switched network).

Shima discloses (page 13, 219<sup>th</sup> – 224<sup>th</sup> paragraphs) when the information terminal 61 requests the web server section 123 of the management server 121 to transfer a general page WP21, the management server 121 returns the general page WP21 to the information terminal 61. The general page WP21 is a page indicating the business machines connected to the network 100 for each type, such as scanners and printers, as shown in Fig. 22 (a control target list having information identifying at least one of the terminals). Shima does not explicitly disclose the information terminal includes a control target list. Szlam discloses (col. 20, lines 9-11) a method of storing the user information of the remote communication device 10 in the controller 225. Therefore, it would have been obvious to one having ordinary skill in the art at the time the

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invention was made to include the general page WP21 in the information terminal in Shima's system, as suggested by Szlam, in order to identify the connected machines in the network 100.

Shima discloses in Fig. 1, the information terminal 11 (information terminal) comprising a read retrieval means 12 (a first control means) for generating retrieval information. Further Shima discloses (page 2, 12<sup>th</sup> paragraph) wherein retrieval information is used to indirectly specify control information, whereby predetermined image information input-output processing is performed. Thus if the user uses an information terminal that can issue retrieval information for using the hypertext information retrieval environment 2 resided within the image information input-output unit 1 (terminal controller generating, based on an instruction from a user, a control command that includes an instruction related to control of the terminal, and information terminal being configured to send the control command to one of the terminals).

Shima does not disclose communication terminal includes a terminal list including information relating to the information terminal. Szlam discloses (col. 20, lines 9-11) the user of the remote communication device 10 (information terminal) can store a user profile in the controller 225 (a communication terminal) which the controller 225 inspects whenever an incoming call for the user is received. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a method of storing user profile of the remote communication device (terminal list including information relating to the information terminal) in the controller 225 (communication terminal) in Shima's system, as suggested by Szlam, in order to authenticate and verifying the originated control commands.

Shima discloses (page 13, 219<sup>th</sup> – 224<sup>th</sup> paragraphs) that if the user chooses a desired parameter out of a read resolution choice page, a URL indicating the parameter is sent to the

management server 121. The URL interpretation section 126 of the management server 121 converts the received URL into a predetermined control command. The control command is transmitted to a predetermined scanner 131, which then interprets the control command, executes scan processing, and transfers an image file provided by scanning to the management server 121, which then transfers the image file received from the scanner 131 to the information terminal 61 (a phone controller performing, based on the multimedia phone communication control command received from the information terminal, the multimedia communication with another terminal on the packet switched network).

With respect to claims 7 and 10, Shima discloses (page 13, 219<sup>th</sup> – 224<sup>th</sup> paragraphs) if the user chooses a desired parameter out of a read resolution choice page, a URL indicating the parameter is sent to the management server 121. The URL interpretation section 126 of the management server 121 converts the received URL into a predetermined control command. The control command is transmitted to a predetermined scanner 131, which then interprets the control command, executes scan processing, and transfers an image file provided by scanning to the management server 121, which then transfers the image file received from the scanner 131 to the information terminal 61 (the phone controller further generates a control command that reports the state of communication with other phone terminal on the packet switched network and sends that control command to the information terminal).

With respect to claim 9, Shima discloses in Fig. 1, a display unit 14 for displaying the control commands sent from the image information input-output unit (information terminal has

an output unit that outputs the retrieved data according to the acquired data control command sent from the communication terminal).

***Allowable Subject Matter***

5. Claims 11, 18-24, 26-27, and 35 are allowed.

The following is an examiner's statement of reasons for allowance:

The prior art does not teach or fairly suggest a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command and a control command that instructs a predetermined multimedia phone communication processing according to a state of the multimedia phone communication and the detected state of the packet-switched phone user and a phone controller performing, based on the multimedia phone communication control command from the information terminal, the multimedia phone communication with another packet-switched phone on the packet switched network, and transmitting a control command that reports the state of the multimedia phone communication with the other packet-switched phone to the information terminal, as specified in independent claim 11.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command and a control command that instructs a predetermined multimedia phone communication processing according to a state of the multimedia phone communication and a phone controller transmitting a control command, that reports the state of the multimedia phone communication, to the information terminal and performing the multimedia phone communication with another packet-

switched phone on the packet switched network according to the multimedia phone communication control command having a highest priority from among a plurality of multimedia phone communication control commands transmitted from the information terminal in response to the multimedia phone communication state control command reporting of the multimedia phone communication state by the phone controller, as specified in independent claim 18.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command and a recorded message information retrieval control command, to one of the packet-switched phone; a phone controller performing, based on the multimedia phone communication control command received from the information terminal, the multimedia phone communication with another packet-switched phone on the packet switched network, and transmitting, based on the recorded message information retrieval control command, a control command including the recorded message information stored in the data storage of the packet-switched phone to the information terminal, as specified in independent claims 19-21.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command and a communication log retrieval control command, to one of the packet-switched phone; a phone controller performing, based on the multimedia phone communication control command received from the information terminal, the multimedia phone communication with another packet-switched phone on the packet switched network, and transmitting, based on the communication log retrieval control command, the retrieved communication log control

command that includes the communication log stored in the data storage of the packet switched phone to the information terminal, as specified in independent claim 22.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command and a message storage control command, to one of the packet-switched phone; a phone controller performing, based on the multimedia phone communication control command received from the information terminal, the multimedia phone communication with another packet-switched phone on the packet switched network, and storing, based on the message storage control command, the message in the data storage, and reporting storage of the stored message to the other packet-switched phone, as specified in independent claim 23.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command and a forward destination setting control command, to one of the packet-switched phone; a phone controller performing, based on the multimedia phone communication control command received from the information terminal, the multimedia phone communication with another packet-switched phone on the packet switched network, storing, based on forward destination setting control command, the forwarding destination setting in the data storage of the packet switched phone, and reporting storage the forwarding destination setting to the other packet-switched phone in a predetermined case, as specified in independent claim 24.

The prior art does not teach or fairly suggest the information terminal comprising a processing table that associates an input unit of a packet switched phone with a predetermined processing; a terminal controller transmitting, based on an instruction from a terminal user, a

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multimedia phone communication control command, and referencing the processing table based on an input occurrence report control command, and performing a processing corresponding to the input unit with the input occurrence; a phone controller performing, based on the multimedia phone communication control command received from the information terminal, the multimedia phone communication with another packet-switched phone on the packet switched network, and transmitting the input occurrence report control command, based upon an input to the input unit, to the information terminal, as specified in independent claim 26.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command and authentication information; a phone controller performing, based on the multimedia phone communication control command received from the information terminal, the multimedia phone communication with another packet-switched phone on the packet switched network; and comparing authentication information included in the multimedia phone communication control command and the authentication information of the terminal list to authenticate the information terminal, as specified in independent claim 27.

The prior art does not teach or fairly suggest the information terminal comprising a terminal controller transmitting a control command, based on an instruction from a terminal user, to control the packet switched hone, and based upon a control command received from the packet switched phone, controlling a multimedia phone communication and/or a terminal function of the information terminal; and the packet switched phone comprising a phone controller controlling at least one of the multimedia phone communication and a phone terminal function on the packet switched network, according to the control command from the

information terminal and transmitting, based on an instruction from a packet switched phone user and/or as a response to the control command from the information terminal, a control command reporting information related to the multimedia phone communication, or an event of the multimedia phone communication with an opposite part of the multimedia phone communication, as specified in independent claim 35.

*Response to Arguments*

6. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh-Vu H Ly whose telephone number is 703-306-5675. The examiner can normally be reached on Monday-Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on 703-305-4378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

avl

  
CHI PHAM  
SUPERVISORY PATENT EXAMINER  
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12/8/03